

**REMARKS**

As a preliminary matter, Applicants note that the form 1449 filed with the December 14, 2001, Information Disclosure Statement has not yet been returned to Applicants. To document the Examiner's consideration of the references cited therein, Applicants request its return with the next Office correspondence.

In the Office Action mailed on June 2, 2005, the Examiner rejected claims 35-37 under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. The Examiner further rejected claims 1, 3-4, 18-23, 27-29, and 35-37 under 35 U.S.C. § 102(e) as being anticipated by *Washington*, U.S. Patent Application Publication No. US 2002/0052777. The Examiner also rejected claims 5-10 and 30-31 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of "User's Guide for TurboTax and TurboTax Deluxe for Tax Year 1997." Finally, the Examiner rejected claims 11-13 and 24-26 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of "Barron's Dictionary of Business Terms, 3d Edition."

By this Amendment, Applicants have amended claims 1, 4, 7, 13, 16, 18, 20, 22, 25, 27, and 35 to point out aspects of the present invention. Applicants have also cancelled claims 6 and 15 without prejudice or disclaimer of the subject matter contained therein. Therefore, claims 1, 3-5, 7-14, 16-31, and 35-37 are currently pending.

**Section 101 Rejections**

Claims 35-37 were rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Applicants respectfully disagree with Examiner's application of a "two-prong test" for statutory subject matter. The source and authority

of this are not given. Furthermore, Applicants contend that claims 35-37, as filed, clearly recite statutory subject matter under the test set forth by the Federal Circuit and followed by the M.P.E.P.: that the claimed invention as a whole produces a “useful, concrete and tangible result....” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998); see M.P.E.P. § 2106. Despite these objections and in order to move this application forward, Applicants have amended claim 35 in an attempt to satisfy the “technological arts” requirement imposed by the Examiner. Accordingly, Applicants request the withdrawal of the section 101 rejections of claim 35 and its dependent claims 36-37.

### **Section 102 Rejections**

Claims 1, 3-4, 18-23, 27-29, and 35-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by the *Washington* reference. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8<sup>th</sup> ed. 2001, 2nd revision May 2004). *Washington* fails to disclose several elements of the claims as amended, and Applicants accordingly request the reconsideration and withdrawal of the section 102 rejections of claims 1, 3-4, 18-23, 27-29, and 35-37.

Claim 1, as amended, recites a method including the step of establishing a transaction before a supplier is selected, said transaction having an associated value that is unrelated to a plurality of supplier classes. The *Washington* reference does not teach such method. Instead, the *Washington* reference teaches setting a goal (called a “POG,” or “project overall goal”) for an amount of money to be awarded to disadvantaged business entities (DBEs). (*Washington*, ¶ 0020.) The *Washington* reference further discloses comparing “money actually paid to DBE’s” to the POG. (*Id.*,

¶ 0032.) The Examiner interprets the money actually paid as teaching the claimed transaction value. However, Applicants amendments clarify that a transaction and its associated value are established before a supplier is selected. Thus, the money actually paid during a project (as disclosed in the *Washington* reference) cannot teach establishing a transaction and its associated value before a supplier has even been selected.

Furthermore, amended claim 1 recites a method including the steps of comparing the transaction value with the value threshold in an automated manner to determine a transaction guideline, and selecting a supplier for the transaction by applying said transaction guideline. The *Washington* reference does not teach such a combination of steps. Instead, the *Washington* reference teaches comparing “money actually paid to DBE’s” to the POG over the lifetime of a project. (*Washington*, ¶¶ 0031-0032.) The comparison disclosed in the reference occurs after suppliers have been selected and paid for performing a project. This is unrelated to the steps of comparing a transaction value and a value threshold to determine a transaction guideline and then selecting the supplier for the transaction by applying the transaction guideline.

Still further, claim 1, as amended, recites the step of selecting said supplier for said transaction by applying said transaction guideline and said determined supplier selection guidelines. Instead, the *Washington* reference generally states that affirmative action regulations track the amount of money awarded to DBEs. (*Washington*, ¶¶ 0009-0010.) The *Washington* reference does not disclose a supplier selection process based on both a transaction guideline and supplier selection guidelines.

Because the *Washington* reference fails to teach every element of claim 1, Applicants request the reconsideration and withdrawal of the section 102 rejections of claim 1 and its dependent claims 3-5, 7-14, and 16-17.

Claim 18, as amended, recites a method including the steps of establishing a transaction before a supplier is selected, said transaction having an associated value unrelated to the plurality of supplier classes. Claim 18 further recites the steps of comparing said transaction value with a value threshold to determine a transaction guideline, and selecting said supplier by applying said transaction guideline and said supplier selection guideline. As discussed above with respect to claim 1, the *Washington* reference does not disclose these steps or this method. Therefore, Applicants request the reconsideration and withdrawal of the section 102 rejections of claim 18 and its dependent claims 19-26.

Amended claim 27 recites an apparatus comprising a monitoring system configured to compare a transaction value with a value threshold to determine a transaction guideline and select a supplier for said transaction by applying the transaction guideline and determined supplier selection guidelines. The *Washington* reference does not disclose such an apparatus for at least the reasons given above with respect to the method set forth in claim 1. Therefore, Applicants request the reconsideration and withdrawal of the section 102 rejections of claims 27 and its dependent claims 28-31.

Amended claim 35 recites a method including the steps of comparing a value of a transaction to a threshold value to determine a transaction guideline and selecting a supplier for the transaction by applying the transaction guideline and determined

supplier selection requirements. As discussed above with respect to claim 1, the *Washington* reference does not disclose these steps or this method. Therefore, Applicants request the reconsideration and withdrawal of the section 102 rejections of claim 35 and its dependent claims 36-37.

### **Section 103 Rejections**

The Examiner rejected claims 5-10 and 30-31 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of "User's Guide for TurboTax and TurboTax Deluxe for Tax Year 1997" (hereafter, *TurboTax*). The Examiner also rejected claims 11-13 and 24-26 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of "Barron's Dictionary of Business Terms, 3d Edition" (hereafter, *Barron's Dictionary*).

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001, 2nd revision May 2004). Because the cited references, taken together or individually, do not teach or suggest every element of claims 5-13, 24-26, and 30-31, Applicants request the reconsideration and withdrawal of the section 103 rejections.

Claims 5-10 depend from amended claim 1 and claims 30 and 31 depend from claim 27. Accordingly, claims 5-10 and 30-31 recite, among other things, methods and apparatus that establish a transaction before a supplier is selected, said transaction having an associated value that is unrelated to a plurality of supplier classes. As discussed above, the *Washington* reference does not disclose or suggest this recitation. Furthermore, *TurboTax* does not cure this defect. *TurboTax* is a guide for completing a

personal income tax return and is unrelated to establishing a transaction and associated value used to select a supplier. Because the combination of the *Washington* reference and *TurboTax* fail to teach or suggest every element of claims 5-10 and 30-31, Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

Claims 11-13 depend from amended claim 1 and claims 24-26 depend from claim 18. Accordingly, claims 11-13 and claims 24-26 recite, among other things, methods including the step of establishing a transaction before a supplier is selected, said transaction having an associated value that is unrelated to a plurality of supplier classes. As discussed above, the *Washington* reference does not disclose or suggest such a method step. Furthermore, *Barron's Dictionary* does not cure this defect. *Barron's Dictionary* is merely cited for its definitions of forecasting and prediction, having to do with foretelling future events. (Office Action, pp. 19-20.) This is unrelated to establishing a transaction and associated value used to select a supplier. Because the combination of the *Washington* reference and *Barron's Dictionary* fail to teach or suggest every element of claims 11-13 and 24-26, Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

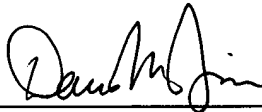
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

PATENT  
Customer No. 22,852  
Attorney Docket No. 08350.1753

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:  *Reg. No.*  
45,777  
(for) David W. Hill  
Reg. No. 28,220